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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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09/690,199

10/16/2000

Billy P. Taylor

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11/27/2007

DAVIS LAW GROUP, P.C.

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SUITE 220

AUSTIN, TX 78746

EXAMINER

EL CHANTI, HUSSEIN A

ART UNIT

PAPER NUMBER

2157

MAIL DATE

DELIVERY MODE

11/27/2007

PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

09/690,199

Applicant(s)

TAYLOR, BILLY P.

Examiner

Hussein A. El-chanti

Art Unit

2157

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 30 October 2007.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1,8,15,25-30,33-38 and 41-46 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1,8,15,25-30,33-38 and 41-46 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____

Response to Amendment

1. This action is responsive to response received on Oct. 30, 2007. Claims 1, 8, 15 and 25-30, 33-38 and 41-46 are pending examination.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

2. Claims 1, 8, 15 and 25, 27-29, 33, 35-37, 41 and 43-45 are rejected under 35 U.S.C. 102(e) as being anticipated by Schilit et al., U.S. Patent No. 6,356,922 (referred to hereafter as Schilit).

As to claims 1, 8 and 15, Schilit teaches a method performed by a computer system and a program product comprising:

storing an electronic version of a paper, wherein the digital version is displayable on a display device as a likeness of the paper (see col.5 lines 9-20 and fig. 2-3, document is stored); and

detecting content of a first portion of the likeness (see col. 5 lines 22-32, annotation is detected); and

after the detecting of the content and in response thereto, forming a hyperlink reference and embedding the hyperlink reference within at least part of the content of

the first portion of the likeness, wherein the hyperlink reference is associated with a second portion of the likeness such that when the first portion of the likeness is displayed on the display device, at least a portion of the content is selectable by a user to cause the computer system to display the second portion of the likeness on the display device (see col. 5 lines 50-col. 6 lines 26, reference links are generated to link to different portions of the same document, wherein the margin of the paper is also considered part of the whole content of the likeness since a page of a book or article consists of textual content and the white space margins on the page and not just text), and

wherein the content is at least one of the following: a term that indicates a location at which the second portion of the likeness is located within the paper (see fig. 2-3).

As to claims 25, 33 and 41, Schilit teaches the method, system and computer readable medium of claims 1, 8 and 15 respectively wherein the content is at least one of the following: a term that indicates a page of the location at which the second portion of the likeness is located within the paper and a phrase that indicates the page (see fig. 2-3).

As to claims 27, 35 and 43, Schilit teaches the method, system and computer readable medium of claims 1, 8 and 15 respectively wherein the content is at least one of the following: a term that indicates a title of the location at which the second portion of the likeness is located within the paper and a phrase that indicates the title (see fig. 2-3).

As to claims 28, 36 and 44, Schilit teaches the method, system and computer readable medium of claims 1, 8 and 15 respectively wherein the paper is at least one of the following: a newspaper, a magazine and a journal (see fig. 2-3).

As to claims 29, 37 and 45, Schilit teaches the method, system and computer readable medium of claims 1, 8 and 15 respectively wherein the electronic version is a first electronic version of the paper and comprising: translating a second electronic version of the paper into the first electronic version (see fig. 2-3).

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

3. Claims 26, 30, 34, 38, 42 and 46 are rejected under 35 U.S.C. 103(a) as being unpatentable over Schilit in view of Robertson et al., U.S. Patent No. 6,486,895 (referred to hereafter as Robertson).

As to claims 26, 30, 34, 38, 42 and 46, Schilit teaches a method and system comprising after the detecting of the content and in response thereto, forming a hyperlink reference and embedding the hyperlink reference within the first portion of the likeness, wherein the hyperlink reference is associated with a second portion of the likeness such that when the first portion of the likeness is displayed on the display device, at least a portion of the content is selectable by a user to cause the computer system to display the second portion of the likeness on the display device (see col. 5 lines 50-col. 6 lines 26, reference links are generated to link to different portions of the same document).

Schilit does not explicitly teach the content is at least one of the following: a term that indicates a page number of the location at which the second portion of the likeness is located within the paper and a phrase that indicates the page number. Robertson teaches a system and method for displaying e-book and creating and highlighting links to different portions of the book. Schilit explicitly teaches the link is a page number and the link is highlighted (see col. 6 lines 15-29 and 58-67).

It would have been obvious for one of the ordinary skill in the art at the time of the invention to use page numbers and highlighting the links in Schilit as taught by Robertson because doing so would make the links easier to identify and therefore provide the user with easy navigation and user friendly browsing of e-books.

4. Applicant's arguments have been fully considered but are not persuasive.

Applicant argues in substance that the annotation is not part of the original content and therefore Schilit does not teach detecting a content of a first portion of the likeness and then generating a hyperlink to a second portion of the document.

In response, Schilit teaches a system and method where a document is segmented into a plurality of passages "portions" and then stores the passages (see col. 5 lines 10-22). The system and method identifies a passage in the document i.e. "a first portion" that has been annotated (see col. 4 lines 48-53 and col. 5 lines 52-55). Then according to the context of the annotated message, a query is generated to find other passages from the plurality of the passages "second portion" that have a similar content (see col. 5 lines 50-57). Then a plurality of hyperlinks are generated to point to the identified passages that have a similar content (see col. 5 lines 66-col. 6 lines 9). Therefore Schilit teaches identifying a passage from the plurality of passage that have been annotated and not identifying annotations as a passage and therefore Schilit teaches the invention as claimed.

5. This is a RCE of applicant's earlier Application No. 09/690,199. All claims are drawn to the same invention claimed in the earlier application and could have been finally rejected on the grounds and art of record in the next Office action if they had been entered in the earlier application. Accordingly, **THIS ACTION IS MADE FINAL** even though it is a first action in this case. See MPEP § 706.07(b). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no, however, event will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

6. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Hussein A. El-chanti whose telephone number is (571)272-3999. The examiner can normally be reached on Mon-Fri 8:30-5:00.

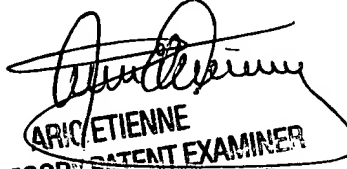
If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Ario Etienne can be reached on (571)272-4001. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

Hussein Elchanti

Nov. 19, 2007


ARIC ETIENNE
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